

### **REMARKS**

Applicant has studied the Office action dated October 9, 2007. It is respectfully noted that the Examiner indicates, in the Office action summary, that only claims 1-15 are pending and have been examined. However, it is respectfully submitted that a preliminary amendment filed at the time of the initial filing of the application on December 27, 2005 and the publication of the present application (US 2006/0137224 A1) clearly show a total of 19 claims in the present application. It is respectfully requested that the Examiner examine pending claims not examined in the Office action dated October 9, 2007.

Currently, claims 1-17 and 20-22 are pending. Claims 1-17 have been amended and claims 18 and 19 have been canceled without prejudice. Claims 20-22 have been newly added. Claims 1 and 21 are independent claims. No new matter has been added as the amendments have support in the specification as originally filed.

It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

#### **Amendments to Specification**

Amendments have been made to the specification at page 1 in order to indicate the priority claim to the foreign application. Accordingly, no new matter has been added.

#### **Claim for Foreign Priority under 35 U.S.C. § 119**

It is respectfully noted that in the Office action of October 9, 2007, the Examiner has not acknowledged the Applicant's claim for foreign priority under 35 U.S.C. § 119. It is respectfully submitted that the foreign priority information is indicated in the Declaration filed with the application on December 27, 2005. In addition, certified copies of the priority documents, 20-2003-0020516, filed on June 27, 2003 and 20-2004-0017787, filed on June 23, 2004 were forwarded to and received by the USPTO on December 27, 2005 as confirmed from the PAIR system.

Accordingly, it is respectfully requested that the Examiner acknowledge Applicant's claims for foreign priority under 35 U.S.C. § 119 and receipt of the certified copies of the foreign priority documents.

#### Amendments to the Claims

Claims 1-17 have been amended to address claim objections based on informalities, correct typographical or grammatical errors or to more clearly disclose the invention. It is respectfully submitted that the amendments have support in the application as originally filed. For example, support for "five toe insert parts with five toe holes provided on a toe portion, wherein each of the five toe holes is provided at an end of each of the five toe insert parts" in amended claim 1 can be found at paragraph [0032] of the published application (US 2006/0137224 A1) and in FIGS. 3, 4, 6, 7, 9, and 10. Support for "four first cut parts" and "four second cut parts" in amended claim 2 can be found, *inter alia*, at paragraph [0039] of the published application (US 2006/0137224 A1) and in FIG. 5. Support for "a top surface of an instep portion of the exterior cover" in amended claim 3 can be found, at least, in FIG. 7. Support for "a top surface of the ankle portion of the exterior cover" in amended claim 4 can be found, at least in FIG. 7. Support for amended claim 14 can be found, for example, at paragraph [0048] of the published application (US 2006/0137224 A1) and in FIG. 6 (60).

#### Objections to Claims

The Examiner objected to claim 13 due to informalities. Specifically, the Examiner asserted that a term "Velcro" recited in claim 13 is a trademark which cannot be used in claims and a generic term must be used instead.

With this paper, claim 13 has been amended to address the Examiner's concerns. It is respectfully submitted that the grounds for objection have been overcome and it is respectfully requested that the Examiner withdraw the objection.

#### § 103 Rejections

Claims 1, 2-4, 6, 7, 10, and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gardiner (US 6,196,986) in view of Swallow et al. ("Swallow" US

4,021,860, further in view of Huggins et al ("Huggins" US 7,051,457). This rejection is respectfully traversed.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court recently stated in In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. 'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.' If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned." (citations omitted.)

It is well-settled that a reference must provide some motivation or reason for one skilled in the art (working without the benefit of the applicants' specification) to make the necessary changes in the disclosed device. The mere fact that a reference may be modified in the direction of the claimed invention does not make the modification obvious unless the reference expressly or impliedly teaches or suggests the desirability of the modification. In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984); Ex parte Clapp, 227 USPQ 972, 973 (Bd. App. 1985); Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. App. 1984).

With regard to independent claim 1, it is respectfully noted that the Examiner asserts, at pages 2-3 of the Office action, that Gardiner discloses all of the elements except for anterior portion and toe holes. Applicant respectfully disagrees with the Examiner's interpretation of Gardiner.

In particular, regarding the asserted disclosure of the toe insert parts, it is noted that the asserted toe insert parts is actually "a front edge 14 which terminates at front opening 16." (col. 1, ll. 60-61 and FIGS. 1-4). It is further noted that the "[f]ront edge 14 is positioned at the base of the wearer's toes." (col. 1, ll. 61-62). It is respectfully submitted that the front edge 14 disclosed in Gardiner, which belongs to top surface 13, which belongs to a foot portion 12, is merely an end of the foot portion, thus entirely

exposing all of the toes through one front opening 16. Therefore, the front edge 14 disclosed in Gardiner cannot be considered to be toe insert parts, recited in claim 1. In addition, claim 1 has been amended to recite five toe insert parts with five toe holes provided on a toe portion, wherein each of the five toe holes is provided at an end of each of the five toe insert parts, further distinguishing the present invention from Gardiner.

It is respectfully submitted that the feature, each of the five toe holes is provided at an end of each of the five toe insert parts, recited in claim 1, specifically, the recitation of end of each of the five toe insert parts implies that each of the five toe insert parts has some length. However, it is respectfully asserted that Gardiner fails to disclose or suggest end of each of the five toe insert parts or each of the five toe insert parts having an end, as recited in claim 1. It is respectfully submitted that this feature prevents the toes from being sprained and the exterior cover from undesirably rotating relative to the foot, thus preventing the anterior and posterior areas of the sole from being displaced from the corresponding anterior and posterior holes, as described at paragraph [0037] of the published application (US 2006/0137224 A1).

Regarding the asserted disclosure of an anterior hole by Swallow, it is respectfully submitted that combining Swallow with Gardiner, lacking the anterior hole, to arrive at the present invention recited in claim 1 is improper because Gardiner discloses a foot protector for use in playing soccer on sand (col. 1, ll. 4-6) while Swallow discloses a therapeutic or anti-embolism stocking which applies a compressive pressure against a patient's leg to increase the velocity of blood flow in the legs, minimizing the possibility of thromboembolism (col. 1, ll. 8-20).

It is respectfully submitted that although the disclosures of both Gardiner and Swallow relate to footwear, the foot wears of Gardiner and Swallow are clearly distinguishable because the foot protector of Gardiner has a completely different purpose from the therapeutic stocking of Swallow. Specifically, the foot protector of Gardiner is used to protect the foot from "active sports" while the therapeutic stocking of Swallow is used to protect the leg from "inactivity of the patient," for example, who is confined to bed, and thus, the likelihood of thrombus is markedly increased due to a decrease in the velocity of blood flow in the patient's legs during confinement.

Therefore, it is respectfully asserted that Gardiner and Swallow are not combinable to arrive at the present invention as recited in claim 1 because both Gardiner and Swallow lack motivation or reason to combine with each other due to their completely opposite purposes. As mentioned above, the mere fact that a reference may be modified in the direction of the claimed invention does not make the modification obvious unless the reference expressly or impliedly teaches or suggests the desirability of the modification. Thus, Swallow fails to cure the deficiencies of Gardiner with regard to the anterior hole recited in claim 1. It is further respectfully asserted that even if Swallow is combined with Gardiner, the deficiencies of Gardiner are not cured by Swallow.

Regarding the asserted disclosure of toe holes by Huggins, it is respectfully noted that Huggins merely discloses five holes completely exposing the entire length of toes (FIG. 12). However, Huggins fails to cure the deficiencies of Gardiner and Swallow with regard to the anterior hole and five toe insert parts with five toe holes provided on a toe portion, wherein each of the five toe holes is provided at an end of each of the five toe insert parts, recited in claim 1.

Therefore, it is respectfully asserted that independent claim 1 is allowable over the cited combination of references. It is further respectfully asserted that claims 2-4, 6, 7, 10, and 15, which depend from independent claim 1, also are allowable over the cited combination of references at least by virtue of their dependence from allowable base claim.

Nonetheless, some of the rejected dependent claims are discussed herewith.

With regard to the rejection of claim 2, which depends from claim 1, it is respectfully noted that the Examiner asserts at page 4 of the Office action, that Huggins teaches an upper piece having cut parts. Applicant respectfully disagrees with the Examiner's interpretation of Huggins with respect to the asserted upper piece having cut parts.

It appears that the Examiner has interpreted the cut parts as five toe inserts or the parts cut at the base of each toe to expose the toes. However, it is noted that the first and second cut parts recited in claim 2 refer to the cuts 46-1 and 46-2, respectively,

positioned between the toes to separate each toe insert part from each other as shown in FIG. 5.

Further, claim 2 has been amended to recite an upper piece having four first cut parts in between the five toe insert parts and a lower piece having four second cut parts in between the five toe insert parts. It is respectfully asserted that the Huggins fails to disclose or suggest at least an upper piece having four first cut parts in between the five toe insert parts and a lower piece having four second cut parts in between the five toe insert parts contrary to the Examiner's assertion. Moreover, even if Huggins is combined with Gardiner and Swallow, they fail to arrive at the presently claimed invention as recited in claim 2.

With regard to the rejection of claim 3, which depends from claim 1, it is respectfully noted that the Examiner asserts, at page 4 of the Office action, that Gardiner teaches an instep protective cover of the exterior cover, citing reference numbers 13 and 12, which refers to a top surface and a foot portion, respectively. Applicant respectfully disagrees with the Examiner's interpretation of Gardiner with respect to the asserted instep protective cover of the exterior cover.

It is noted that Gardiner discloses, at col. 1, ll. 57-60, "[t]he foot portion 12 has a top surface 13 and a bottom surface 15." It is further noted that the top surface 13 and the bottom surface 15 together form the foot portion 12, and thus, the top surface 13 (asserted to be an instep protective cover) is not attached to the foot portion 12 (asserted to be the exterior cover) since they are not separate elements in Gardiner contrary to the Examiner's assertion. Therefore, it is respectfully asserted that Gardiner fails to disclose or suggest an instep protective cover attached to a top surface of an instep portion of the exterior cover, as recited in claim 3. It is further respectfully asserted that Swallow and Huggins fail to cure the deficiencies of Gardiner with regard to an instep protective cover attached to a top surface of an instep portion of the exterior cover, recited in claim 3.

With regard to the rejection of claim 4, similar to the discussion above in connection with claim 3, it is respectfully asserted that Gardiner fails to disclose or suggest an ankle protective cover attached to a top surface of the ankle portion, as

recited in claim 4. It is further respectfully asserted that Swallow and Huggins fail to cure the deficiencies of Gardiner with respect to an ankle protective cover attached to a top surface of the ankle portion, recited in claim 4.

With regard to the rejection of claims 6 and 7, which depend from claim 3, as discussed above in connection with claim 3, it is respectfully asserted that the cited combination of references fails to disclose or suggest the instep protective cover recited in claims 3, 6 and 7.

With regard to the rejection of claim 10, which depends from claim 4, as discussed above in connection with claim 4, it is respectfully asserted that the cited combination of references fails to disclose or suggest the ankle protective cover recited in claims 4 and 10. It is further respectfully asserted that the cited combination of references fails to disclose or suggest a coupling part fixed to the ankle portion of the exterior cover and an instep portion and the ankle portion while the flap is not fixed to the exterior cover.

With regard to the rejection of claim 15, which depends from claim 1, it is respectfully noted that the Examiner is silent with respect to "sides of the toe insert parts." As discussed above in connection with independent claim 1, Gardiner fails to disclose or suggest the five toe insert parts, and thus, also fails to disclose or suggest sides of the five toe insert parts, recited in claim 15. It is further respectfully asserted that Swallow and Huggins fail to cure the deficiencies of Gardiner with respect to sides of the five toe insert parts, recited in claim 15.

Accordingly, it is respectfully asserted that, in addition to the allowable independent claim 1, dependent claims 2-4, 6, 7, 10, and 15 are also allowable over the cited combination of references not only by virtue of their dependency from allowable claim 1, but also by their distinguishable features.

Claims 5, 8, 9, and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gardiner, Swallow, and Huggins, further in view of Brother et al. ("Brother" US 6,234,988). This rejection is respectfully traversed.

It is respectfully noted that Brother has been cited by the Examiner for disclosing a cushioning layer. However, as discussed above in connection with claims 3 and 4,

Gardiner, Swallow, and Huggins, independently or in combination, fail to disclose or suggest the instep protective cover and the ankle protective cover, respectively. It is respectfully asserted that Brother fails to cure the deficiencies of the above cited combination of references with respect to the instep protective cover and the ankle protective cover, cited in claims 3 and 4, respectively. It is further respectfully asserted that Brother also fails to cure the deficiencies with respect to claim 1.

Accordingly, it is respectfully asserted that claims 3 and 4, which depend from allowable independent claim 1, are allowable over the cited combination of references including Brother. It is further respectfully asserted that claims 5 and 8-9, which depend from claims 3 and 4, respectively, and recite the instep protective cover and the ankle protective cover, respectively, also are allowable over the cited combination of references. Furthermore, it is respectfully asserted that claim 11, which depends from claim 5, is allowable at least by virtue of its dependency from the allowable base claim.

Claims 12-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gardiner, Swallow, and Huggins, further in view of Corry (US 5,867,838). This rejection is respectfully traversed.

It is respectfully noted that Corry has been cited by the Examiner for disclosing an elastic band at the ankle portion. However, as discussed above in connection with claim 1, Gardiner, Swallow, and Huggins, independently or in combination, fail to disclose or suggest the presently claimed invention as recited in claim 1. It is respectfully asserted that Corry fails to cure the deficiencies of the above cited combination of references at least with respect to the anterior hole and five toe insert parts with five toe holes provided on a toe portion, wherein each of the five toe holes is provided at an end of each of the five toe insert parts, recited in claim 1.

Accordingly, it is respectfully asserted that independent claim 1 is allowable over the cited combination of references including Corry. It is further respectfully asserted that claims 12-14, which depend from independent claim 1, also are allowable at least by virtue of its dependency from the allowable base claim.



In view of the above arguments, it is respectfully asserted that the Examiner has failed to establish a prima facie case of obviousness and, therefore, independent claim 1 is allowable over the cited combination of references, as are claims 2- 14, which depend from claim 1.

### New Claims

With this paper, new claims 20-22 have been added. It is respectfully submitted that the new claims have support in the application as originally filed. For example, support for claim 20 can be found, *inter alia*, at paragraph [0037] of the published application (US 2006/0137224 A1) and in FIGS. 3-7 and 9-10. In particular, FIG. 9 shows that the toe insert parts (40) are extended to cover at least parts of the toes. Support for claim 21 can be found in paragraphs [0039] of the published application (US 2006/0137224 A1) and in FIGS. 5-7 and 10. Support for claim 22 can be found in paragraphs [0033] of the published application (US 2006/0137224 A1) and in FIGS. 6 and 7.

It is respectfully asserted that claim 20, which depends from allowable independent claim 1 is allowable at least by virtue of its dependence from an allowable base claim. In addition, none of the cited references discloses or suggests that each of the five toe insert parts extends toward each of the five toe holes to cover at least a part of each of five toes, as recited in claim 20. It is noted that Huggins, which was cited for disclosing toe holes, merely discloses toe holes without any extension (FIG. 12) as the holes were formed by simply cutting the entire toe parts 130 shown in FIG. 11D. Therefore, even if Huggins is combined with Gardiner, which was cited for disclosing a toe portion, but actually disclosing "a front edge 14 which terminates at front opening 16" and "[f]ront edge 14 is positioned at the base of the wearer's toes," or with any other references, they fail to disclose or suggest that each of the toe insert parts extends toward each toe to cover at least a part of each toe.

It is respectfully asserted that independent claim 21, which recites limitations similar to those of claims 1 and 2, is allowable for the same reasons given herein with regard to claims 1 and 2. It is further respectfully asserted that claim 22, which depends from claim 21, also is allowable at least by virtue of its dependency from an allowable

base claim. Moreover, it is respectfully submitted that none of the cited references disclose or suggest that the ankle securing means is connected to the exterior cover by sewing or adhesive bonding, as recited in claim 22.

### CONCLUSION

In view of the above remarks, Applicant submits that claims 1-17 and 20-22 of the present application are in condition for allowance. Reexamination and reconsideration of the application, as originally filed, are requested.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

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